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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/932,993	09/18/97	MCKAIN	J A0521/7118
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EXAMINER

CHRISTENSEN, A

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 10/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/932,993

Applicant(s)
McKain et al.

Examiner
Andy Christensen

Group Art Unit
2612



☒ Responsive to communication(s) filed on Aug 7, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-17 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. The Applicant is hereby notified that the Examiner's Art Unit has been changed from 2712 to 2612.
2. The Applicants' amendment to the specification filed August 7, 2000 has overcome the objection to then specification and the objection is withdrawn.
3. The Applicants' amendment to the claims filed August 7, 2000 has overcome the 25 USC 112 rejection and the rejection is withdrawn.
4. The Applicants arguments filed August 7, 2000 have been fully considered by the Examiner.

The Applicants argue that col.3, lines 62-65 does not teach an editing function as being provided in a system separate from the camera. Although Washino et al. teach that the editing function is performed in the video camera (Column 8, Lines 55-56), the Examiner agrees that this portion of Washino et al. reference does not specifically disclose the display as being included within the camera. A new reference will be cited to teach this feature, and therefore this Office Action is made NON-FINAL.

The remainder of the Applicants' arguments are not deemed to be persuasive.

The Applicants assert that column 8, lines 55-57 of Washino et al. teaches editing

functions to be separate from the camera. However this portion of Washino et al. specifically states that "FIG.3 shows the functional diagram for the storage-based digital recorder employed in the video camera--" (emphases added).

The Applicants argue that there is no mention of a "switch" in column 12, lines 12-33 and that the Examiner has incorrectly assumed that a switch is required in Washino et al. to "provide an output consisting of a combination of the images from the two sources (which are the Digital Inputs and the Data Bus in Fig 4).

In response the bus controller shown in Figure 4 clearly functions as a switch in that any one of four separate sources may be routed onto the data bus thereby.

The Applicants argue that Figure 4 of Washino et al. refers to production facilities and not a camera. However Figure 4 is a variation of Figure 3 (as stated in column 9, lines 39-41), which is specifically referred to as being performed "in the video camera" (Column 8, Lines 55-56).

The Applicants argue that column 1, lines 10-15 states that the editing functions are a provided in a system separate from a recording device such as a camera.

In response, column 8, lines 55-56 specifically states that the editing functions (for example as shown in Figure 3) are performed "in the video camera". These clearly are editing functions such as those referred to in the introductory portion presented in column 1, lines 10-15.

The Applicants argue that the features presented in Claims 1, 4, 5 and 6 are not disclosed in Washino et al. as being provided in the housing. However, Washino et al. specifically state that its editing functions are performed "in the video camera" (Column 8, Lines 55-57).

The Applicants argue that Washino et al. do not teach a second encoder within the housing of a camera and a second switch.

In response, the encoder present in item 124 of Figure 4 is a second encoder. In addition, it is noted that Claim 9 does not recite a "second switch". It is clear that there is an means in item 124 to select from one of the first and second inputs since the output provided therefrom may be from either a camera ("digital inputs") or an input from of the data bus, as described in column 12, lines 12-23. Furthermore, as stated previously, these function are "employed in the video camera" (Column 8, Lines 55-56).

The Applicants argue that Washino et al. ('433) only teaches instructions that were generated "off line" and therefore must be related to recorded media. However the term "off-line" refers to the edit-list decisions that have been made regarding the sequencing of the various inputs to be included in an editing operation (Column 7, Lines 8-11). One of the inputs provided in Washino et al. ('157) is live video (see for example, Column 14, Lines 46-48).

The Applicants argue that the reference lacks evidence to support the motivation alleged by the Examiner for the combination. The Examiner disagrees. The edit-list compiled in Washino

et al. ('433) is stated in column 7, lines 25-26 as serving to "automate" an editing operation and thus clearly would apply to that such as performed in Washino et al. ('157).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the broadcast television quality motion video signal" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-2, 4-7 and 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Washino et al. (U.S. Patent No.5,537,157).

Regarding Claim 1, Washino et al. disclose a digital motion picture recorder comprising a housing sized to be portable for use by an individual (Column 6, Lines 63-64; Column 8, Lines 55-56), a decoder mounted in the housing for receiving a broadcast television quality full motion

picture video signal and for converting the broadcast television quality full motion video signal into a plurality of digital still images (Figure 2a; Items 50,52), a digital computer-readable and writeable random access medium (Figure 3, Item 70; Figure 4, Item 104) mounted in the housing and connected both to receive and store and to retrieve and playback the plurality of digital still images in a computer-readable file format, an encoder mounted in the housing having an input for receiving a sequence of digital still images for generating as an output a full motion video signal (Column 10, Lines 11-18), a switch mounted in the housing having a first input receiving the plurality of digital images from the decoder and a second input receiving the plurality of digital still images from the digital computer-readable and writeable random-access medium and an output connected to the input of the encoder (See Column 12, Lines 12-23 where such a switch is clearly present), and an interface on the housing responsive to user input to cause the switch to provide one of the first and second inputs as the sequence of digital still images to the input of the encoder (See Column 8, Line 65 - Column 9, Line 9 with Column 12, Lines 12-23 and Column 14, Lines 35-53 where such an interface is clearly present).

Regarding Claim 2, Washino et al. disclose a motion picture editing system within the housing (See Column 8, Lines 55-56 and note that the Washino et al. device is an editing system as disclosed in Column 1, Lines 10-15).

As to Claim 4, see Examiner's comments regarding Claim 1 and note that Washino et al.

disclose a camera mounted on the portable housing having an output providing a video signal that is input to the decoder (Figure 2c).

As to Claim 5, see Examiner's comments regarding Claims 1 and 4.

As to Claim 6, see Examiner's comments regarding Claim 1.

Regarding Claim 7, Washino et al. disclose a means (Figure 3, Items 72, 74; Figure 4, Items 106, 110) for selectively operating the means for storing to store the received video signal as digital video information or to direct stored video information to the encoder.

Regarding Claim 9, Washino et al. disclose a second encoder having a first input connected to receive stored digital video information and a second input connected to receive the received video signal, and an output providing an output video signal according to a selected one of the first and second inputs, and a means for causing the second encoder to select from one of the first and second inputs (See Figure 4 and note that encoders are supplied for each of a plurality of digital inputs).

Regarding Claim 10, Washino et al. disclose an audio encoder (Figure 4, Item 136) having a first input connected to receive input audio information and a second input connected to receive stored audio information, and an output providing an output audio signal according to a selected

one of the first and second inputs, and a means for causing the audio encoder to select from one of the first and second inputs (Column 12, Lines 4-11).

Regarding Claim 11, Washino et al. disclose a first bus (Figure 4; "Digital Inputs") connecting the means for receiving the video signal to the first input of the encoder, and a second bus (Figure 4; "Data Bus") connecting the means for storing to the second input of the encoder (See also Column 12, Lines 15-21).

Regarding Claim 12, Washino et al. disclose a camera mounted on the portable housing having an output providing a broadcast television quality motion video signal (Figure 2c).

Regarding Claim 13, Washino et al. disclose a media data buffer (Figure 3; Item 72) which receives sequences of digital still images from the decoder and outputs the sequence of digital still images to the digital, computer readable and writeable random access medium and further comprising a processor (Figure 3; Item 74) for controlling data flow between the media data buffer and the computer readable medium.

Regarding Claim 14, Washino et al. disclose a first pixel bus (Figure 4; "Digital Inputs") for transmitting received sequences of digital still images from the decoder, and a second pixel bus (Figure 4; "Data Bus") for transmitting sequences of digital still images from the digital, computer

readable and writeable random access medium wherein the first and second pixel buses are both connected to the switch (See Column 12, Lines 12-23 and Column 14, Lines 45-53 and note that such a connection is clearly present in order to provide an output consisting of images from either of the two sources).

Regarding Claim 15, Washino et al. disclose that the digital, computer-readable and writeable random access medium is a disk drive having a capacity to store several minutes of sequences of digital still images (Column 8, Lines 34-53).

Regarding Claim 16, Washino et al. disclose a means for receiving, digitizing and storing audio signals in synchronization with the motion video signals and for selecting audio from at least one of a plurality of audio channels (Column 12, Lines 4-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al. in view of Morita (JP5-153448).

Regarding Claim 3, it is clear that editing controls are present on the housing when the editing operation is performed in the video camera (See Column 14, Lines 35-53). It is also clear that when the editing operation in Washino et al. is performed in the video camera a display must be present on the housing, but the location of the display in Washino et al. is not specifically stated to be on the housing. However Morita shows both editing controls and a display on the housing of a camera/editing device (See Figures 2 and 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the display of Washino et al. on the housing in order to permit the performing of the editing operation in the video camera.

Regarding Claim 17, Washino et al. disclose a digital video recording device comprising a portable housing (Column 6, Lines 63-64; Column 8, Lines 55-56); a camera attached to the portable housing and having an output providing digital video information (Figures 2a and 3) ; a random access, computer-readable and writeable medium (Figure 3, Item 70; Figure 4, Item 104) mounted within the portable housing and connected to receive and store the digital video information from the camera; a first encoder (Figure 4; Item 124) mounted within the portable housing and providing output video information and having an input for receiving digital video information; a second encoder (Figure 4; Item 120) mounted within the portable housing and providing an output video signal to a display (Column 10, Lines 11-21); a first switch mounted within the portable housing and having a first input for receiving digital video information from a decoder and a second input for receiving digital video information from the random access

computer-readable and writable medium, and an output connected to provide the digital video information to the input of the first encoder (See Column 12, Lines 12-23 where such a switch is clearly present); a second switch mounted within the portable housing and having a first input for receiving digital video information from the decoder and a second input for receiving digital video information from the random access computer-readable and writeable medium, and an output connected to provide the digital video information to the input of the second encoder (See Column 12, Lines 12-23 where such a switch is clearly present); and an interface on the portable housing responsive to user input to enable the user to control the first switch and the second switch (See Column 14, Lines 35-53 where such an interface is clearly present).

Although it is clear that when the Washino et al. device is employed in a video camera (See Column 8, Lines 55-56) the display must be mounted on the portable housing, but the location of the display in Washino et al. is not specifically disclosed as being on the housing. However Morita shows both editing controls and a display on the housing of a camera/editing device (See Figures 2 and 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the display of Washino et al. on the housing in order to permit the performing of the editing operation in the video camera.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al. ('157) in view of Washino et al. (U.S. Patent No. 5,488,433).

Washino et al. ('157) disclose an editing system for integrating any combination of live

camera signals, prerecorded materials and scanned images (Column 12, Lines 19-21) but do not disclose generating a play list that includes instruction on how to do so.

However Washino et al. ('433) disclose such an arrangement for a similar device (Column 7, Lines 7-30) whereby the editing operation is automated and permits the use of instructions generated off-line (Column 7, Lines 25-31). Use of such a play list in Washino et al. ('157) would clearly increase the speed of the editing operation by automating the process and/or permitting previously generated instructions to be used. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a play list in Washino et al. ('157) in order to increase the speed and versatility of the editing operation.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-6306 (for informal or draft communications; please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

10. Any inquiry regarding this communication or earlier communications from the examiner should be directed to Andy Christensen whose telephone number is (703) 308-9644.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Wendy Garber, can be reached on (703) 305-4929.

Application/Control Number: 08/932,993
Art Unit: 2612

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

ac
October 17, 2000



ANDREW CHRISTENSEN
PATENT EXAMINER